UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,129	05/31/2000	Scott T. Hughes	K35A0614	3846

26332 7590 09/10/2004

WESTERN DIGITAL CORP.
20511 LAKE FOREST DRIVE
C205 - INTELLECTUAL PROPERTY DEPARTMENT
LAKE FOREST, CA 92630

EXAMINER	
BACKER, FIRMIN	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/585,129
Filing Date: May 31, 2000
Appellant(s): HUGHES ET AL.

BRUCE S. ITCHKAWITZ
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 18th 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

2002/0072965	Merriman et al	6-2002
6,339,761	Cottingham	1-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al (U.S. PA Pub. No. 2002/0072965 A1) in view of Cottingham (U.S. Patent No. 6,339,761).

3. As per claim 1, Merriman et al teach a method of operating a content delivery system for distributing advertising content *(methods and apparatuses for delivery of advertisements)* to users of personal computers *(users' browser, 16)*, *(see fig 1, 2)* comprising collecting *(gathers)* identification data *(information about individual users)* from a network *(network 10)* of personal computers, receiving the advertising content from an advertiser *(see page 2 paragraph 0026)*, formatting the advertising content for storage and display in the personal computers *(see page 3 paragraph 0021),* and distributing, using the collected identification data, the formatted advertising content to the personal computers *(see page 2 paragraph 0017, 0018, 0021)*. Merriman et al fail to teach an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or

before bootloading a user selected application environment. However, Cottingham teaches an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (*see column 23 lines 35-43, 7 lines 50-58).* Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Merriman et al's inventive concept to include Cottingham's personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment because this would have allowed advertiser to track consumer response to specific elements of the Web page/application environment as well as to better infer information about the user's interests in an effort to qualify the user prior to presenting subsequent advertising.

4. As per claims 2, 3, Merriman et al teach a method wherein the identification data comprises a unique identifier/internet protocol that is associated with one of the personal computers *(see page 2 paragraph 0018).*

5. As per claim 4, Merriman et al teach a method of receiving preference data from the personal computers; and selecting the advertisement data that is to be distributed, at least in part, based upon the received preferences (*see page 2 paragraph 0017, 0018, 0021).*

6. As per claim 5, Merriman et al teach a method of associating a fee with data representative of the advertiser, and storing the fee in a storage device (*see page 3 paragraph 0021).*

7. As per claim 6, Merriman et al teach a content delivery system comprising for distributing advertising data (*methods and apparatuses for delivery of advertisements)* to a network of personal computers (*users' browser, 16)*, (*see fig 1, 2)* comprising an identification database comprising identification data, wherein the identification data uniquely identifies a computer or a user in the network of personal computers (*information about individual users)* (*see page 2 paragraph 0017, 0018, 0021)*, an advertisement database comprising advertising data (*advertising server processes, 19)*, a collection module for collecting the identification from the network of personal computers and storing the collection information in the identification database (*see page 2 paragraph 0017, 0018, 0021)*, a formatting module for formatting and storing advertisement data in the advertisement database (*see page 3 paragraph 026)*, and a control module that distributes the formatted advertising data to the network of personal computers upon the occurrence of one or more events (*see page 2 paragraph 0017, 0018, 0021).* Merriman et al fail to teach an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment. However, Cottingham teaches an inventive concept wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment (*see column 3 lines 35-43, 7 lines 50-58).* Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to modify Merriman et al's inventive concept to include Cottingham 's personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment because this would have allowed advertiser to track consumer response to specific elements of the Web page/application environment as well as to better infer information about the user's interests in an effort to qualify the user prior to presenting subsequent advertising.

8. As per claims 7, 8, Merriman et al teach a content delivery system wherein the identification data comprises a unique identifier/internet protocol that is associated with one of the personal computers *(see page 2 paragraph 0018)*.

9. As per claim 9, Merriman et al teach a content delivery system wherein the control module receives preference data from the personal computers, and wherein the control module selects the advertisement data that is to be distributed, at least in part, based upon the received preferences (*see page 2 paragraph 0017, 0018, 0021)*.

10. As per claim 10, Merriman et al teach a content delivery system wherein the control module associates a fee with data representative of the advertiser; and wherein the control modules stores the fee in a storage device that is associated with one of the personal computers *(see page 2 paragraph 0026)*.

*(11) **Response to Argument***

a. Appellant argues that the prior art, Merriman et al taken alone or in combination with Cottingham, fails to teach an inventive concept of collecting identification data of personal computers configured to receive and store content and display advertisement content while or before bootloading a user application users information. Examiner respectfully disagrees with applicant characterization of Merriman et al's inventive concept. Merriman et al teach in paragraph 10 a system and methods wherein information about networks and subnetworks is routinely collected. In addition, information about individual users is also gathered when users select (click on) different advertisements. Also, data is tracked on how often a given advertisement has been displayed, how often a given user has seen a given advertisement, and other information regarding the user and the frequency of the display of the advertisement. Cottingham further teach an inventive concept wherein an advertisement (or advertising) may be communicated to a customer before the communication of a web-page or other information requested by the customer from a content provider. The first-communicated advertisement may be displayed on the computer of the customer for a predetermined period of time before communication of the web-page from the provider to the customer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Firmin Backer
Primary Examiner
Art Unit 3621

September 2, 2004

Conferees

James Trammell

Joseph Thomas J.T.

WESTERN DIGITAL CORP.
20511 LAKE FOREST DRIVE
C205 - INTELLECTUAL PROPERTY DEPARTMENT
LAKE FOREST, CA 92630